

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1, 3, 6-9, 11, 13-15 and 17-28 are now present in this application.

Claims 1, 8, 15, 19, 24, 25 and 26 are independent. Amendments have been made to independent claims 1, 8, 15, 19, 24, 25 and 26. No new matter is involved. Claims 4, 5, 10, 12 and 16 have been cancelled. Reconsideration of this application, as amended, is respectfully requested.

Rejection Under 35 U.S.C. §102

Claims 1, 3, 4, 8-11, 15, 19-21 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,038,216 to Easterly et al. (hereinafter, "Easterly"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Claims 4 and 10 have been canceled and, therefore, this rejection is moot with respect to claims 4 and 10.

Independent claims 1, 8, 15, 19 and 25 are not anticipated by Easterly. Claim 1 recites a number of steps including switching a photographing mode of a camera. Easterly does not perform the claimed invention. Easterly is directed to obtaining automatic color balancing of color photographic images for subsequent

display on a color monitor in a film-to-video transfer system. See the preamble of claim 6 of Easterly, for example, and col. 4, lines 10-64, for example. Easterly does not disclose switching a photographic mode of a camera in any manner whatsoever.

The Office Action alleges that the switching of a photographic mode based on the comparison of illumination levels is disclosed in col. 18, line 62 to col. 19, line 11. (Applicant notes that this is a different basis for the rejection than in the previous Office Action, which relied on col. 4, lines 52-59 and col. 33, lines 24-28 for such a teaching, and thus, the last Office Action was improperly and prematurely made a final Office Action.)

However, col. 18, line 62 to col. 19, line 1 of Easterly merely disclose details of an apparatus, including a variable aperture that automatically controls brightness of an optical image that is translated into digital samples.

Also, in col. 33, lines 24-28, which are part of Easterly's claim 1, the automatic brightness control, including means to vary an aperture, is claimed. There is no disclosure of switching the mode of a camera, here, either.

However, there is no disclosure in Easterly of switching the mode of a camera as defined by Applicant. As noted above, varying the aperture is not changing the photographic mode. It is merely operating within a particular photographic mode, i.e., an aperture control mode.

Additionally, Applicant's originally filed specification, page 8, lines 16-18, clearly states “[H]ere, the meaning of switching the photographing mode of the camera is photographing the scene by using an OLPF in the lens unit or without using the OLPF. The lens unit is a lens assembly or lens module and includes a lens group.”

In other words, Applicant has defined “switching the photographing mode of the camera” as “photographing the scene by using an OLPF in the lens unit or without using the OLPF,” where OLPF is defined as “optical low pass filter” (specification, page 2, lines 6-7).

In view of the case law cited above, it is clear that Applicant's claims have to be interpreted consistently with Applicant's specific definition of switching the photographic mode of the camera, which is quoted above, and found in Applicant's specification as originally filed.

Accordingly, the Examiner's interpretation of Easterly is improper and this rejection of claims 1, 3, 4, 8-11, 15, 19-21 and 25 as anticipated by Easterly is improper and should be withdrawn.

Furthermore, because claim 3 depends from claim 1, claims 9-11 depend from claim 8, and claims 20-21 depend from claim 19, dependent claims 3, 9-11, 20 and 21 are not anticipated by Easterly.

Reconsideration and withdrawal of this rejection of claims 1, 3, 4, 8-11, 15 19-21 and 25 is respectfully requested.

Rejections under 35 U.S.C. §103

Claim 24 stands rejected under 35 U.S.C. §103(a) as unpatentable over Easterly et al. ("Easterly"). This rejection is respectfully traversed.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the

burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Also, the factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness should be made.

However, these inquiries are not found in this rejection.

Easterly does not disclose the features recited in independent claims 1, 15, 19, 24 and 26, at least for the reasons stated above. So, even if it were obvious to modify Easterly, as suggested, the resulting modified version of Easterly would not render the claims obvious.

Furthermore, Applicant respectfully requests that what is being relied on by way of "official notice" be supported by objective factual evidence, as required by the "In re Lee" decision, cited above.

Also, Applicant respectfully submits that it is improper to take official notice of obviousness, which is what is being done here, rather than taking official notice of the existence of some fact.

Accordingly, this rejection of claim 24 is improper and should be withdrawn.

Reconsideration and withdrawal of this rejection of claim 24 is respectfully requested.

Claims 1, 5-8, 12-19, 22 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,172,220 to Beis in view of U.S. Patent 5,038,216 to Easterly. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because claims 5, 12 and 16 have been canceled, this rejection is moot with respect to claims 5, 12 and 16.

Beis does not disclose the invention recited in independent claims 1 and 19 at least for the reasons stated above. Easterly does not disclose the features recited in independent claims 1, 15, 19, 24 and 26, at least for the reasons stated above.

Applicant respectfully submits that the discussion of Beis on page 9 of the rejection is incomplete and misleading. The “twilight switch” of Beis is discussed above, and is used by Beis to decide when to switch from a daylight mode to a nighttime mode. Beis discloses an embodiment in which he uses a single detector with different sensing elements for black and white and different sensing elements for color. No specific detector patterns are disclosed. Beis discloses “the magnitudes of the electrical output signals or image signals can be used” as the twilight switch. No details of how the image signals are used are presented.

Moreover, as discussed above, Applicant respectfully submits that Beis only discloses using magnitudes of electrical output signals or image signals as alternatives to use of a light sensitive switch. Beis only discloses that a twilight switch is one type of light sensitive switch, and clearly discloses using magnitudes of electrical output signals or image signals as alternatives to light sensitive switches. Beis does **not** disclose alternative types of twilight switches. Beis switches from a daytime mode to a nighttime mode based on “. . . a light sensitive switch, e.g., a twilight switch, which is activated when the intensity of the incoming light reaches a threshold value. Alternatively, the magnitudes of the electrical signals or image signals can be used.” – see col. 2, lines 30-36.

Additionally, Beis does not disclose or suggest a combination of features, including detecting an illumination level of each cell region; and switching the photographing mode of the camera on the basis of determining whether the detected illumination level of each cell region is higher than a previously determined standard illumination level, as recited.

The Office Action then turns to Easterly, which has nothing to do with switching between a daytime photographing mode and a nighttime mode of operation of a camera, but is directed to a device that automatically balances the colors in an image being transferred from film to video from a photographic medium to an electronic medium.

The Office Action alleges that Easterly teaches that a camera may switch to a low light intensity mode when the number of cell regions having a lower illumination level than the standard illumination level is greater than a certain percentage of the total number of cell regions, referencing col. 18, lines 64-70 and col. 33, lines 31-34. Applicant disagrees.

Col. 18, lines 64-70 of Easterly concerns scanning a transparency and providing maximum pixel values. Col. 33, lines 31-34 of Easterly recite a means to open an aperture through which an image is transmitted for digitization. The Office Action speculates that “providing in Beis a statistical method for considering the illumination of the plurality of cell regions” would make the determination to switch

modes more robust by factoring in all available illumination information. However, the Examiner provides no objective evidence for this speculative general assertion.

Then, based on this speculative general statement, the Office Action concludes that it would be obvious to use the statistical method of Easterly to modify Beis in order to make the mode-switching decision accurately. Applicant respectfully submits that the Office Action fails to meet its burden of demonstrating proper motivation for one of ordinary skill in the art to modify Beis as proposed.

In the first place, the Office Action does not address the fact that Beis and Easterly are concerned with distinctly different problems, and that they function differently. Beis discloses a surveillance camera with a fixed lens that has a simple twilight switch to switch between a daytime mode and a nighttime mode of operation. Beis has no disclosure of a need to modify its twilight switch. Beis also does not disclose (as admitted in the rejection) counting the number of cell regions having a lower illumination level than the standard illumination level and determining whether the counted number is greater than a certain percentage of the total number of cell regions.

In the second place, Easterly contains no disclosure of (1) a surveillance camera, (2) a daytime mode of operation and a nighttime mode of operation; or (3) a switch to switch between the daytime mode of operation and the nighttime mode of operation.

In the third place, the Office Action fails to provide objective evidence that one of ordinary skill in the art would desire to modify a surveillance camera like that of Beis with a film to video transfer system, especially a certain part of that system that has to do with properly balancing colors in an image being transferred from film to an electronic medium. Beis has no such feature or a need for such a feature.

The mere fact that these two references may be combined in some way does not make the modification obvious unless the prior art suggested the desirability of the modification.

All that is presented in terms of motivation is the alleged desirability of providing a statistical method of Easterly's color balancing system to Beis. However, this statement is nothing more than a broad, conclusory speculative statement that, standing alone, is not evidence of motivation to modify Beis and provide Beis with such a system. See In re Dembiczak, cited above, in this regard.

Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). No such objective evidence is presented. All that is presented is a speculative generalized statement that does not constitute a clear particular motivation to combine such disparate references. Accordingly, the motivation for

modifying Beis to include the claimed features must be based on speculation and/or impermissible hindsight.

The Office Action also tries to demonstrate that Easterly is reasonably pertinent to the particular problem with which Beis is concerned. In an attempt to do this, the Office Action goes to the most generic level possible, e.g., by stating that both references address analogous problems of producing an optimal exposure.

As noted above, Applicant's response to this is that there are hundreds or thousands of U.S Patents that address problems of producing an optimal exposure, and this is not a detailed enough reason to motivate one of ordinary skill in the art to redesign Beis to replace Beis' working system to incorporate a complicated film-to-video transfer system's brightness control system just to make Beis' system, that has not been shown to be in need of being made more robust, more robust.

For at least the aforementioned reasons, the Office Action fails to make out a *prima facie* case of proper motivation to modify Beis in view of Easterly, as suggested, and thus, fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1, 5-8, 12-19, 22 and 26 is respectfully requested.

Claims 23, 27 and 28 stand rejected under 35 USC §103(a) as unpatentable over Beis in view of Easterly and further in view of Suzuki. This rejection is respectfully traversed.

For reasons discussed above, Applicant respectfully submits that claim 19 (from which claim 23 depends) is not anticipated by Easterly nor is claim 26 (from which claims 27 and 28 depend) rendered obvious over Beis in view of Easterly.

Furthermore, Suzuki is not applied to remedy the aforementioned deficiencies in the Beis and Easterly references.

Accordingly, even if one of ordinary skill in the art were motivated to provide an OLPP to the combination of Beis and Easterly, the resulting modification of the base references would not result in, or render obvious, the claimed invention.

Reconsideration and withdrawal of this rejection of claims 23, 27 and 28 is respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

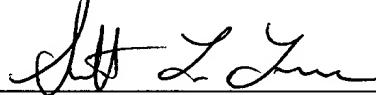
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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